

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	\$	
Breen, John J. et al	\$	
Serial No. 10/688,546	\$	Confirmation No.: 1162
Filed: October 17, 2003	\$	Group Art Unit: 2116
For: INFORMATION HANDLING SYSTEM	\$	Examiner: Yanchus III, Paul B.
INCLUDING FAST ACTING	\$	
CURRENT MONITORING AND	\$	
THROTTLING CAPABILITY	\$	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Responsive to the Final Office Action, dated July 18, 2007 please consider the following remarks in connection with the pre-appeal brief request for review. Review of the final rejection is requested for the following reasons.

The rejection of claims 1-23 is not supported by a *prima facie* case of obviousness for claims 1-23.

Claims 1-23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA hereinafter), in view of Atkinson (U.S. Patent No. 6,498,460) (Atkinson hereinafter).

A *prima facie* case of obviousness is missing, however, at least because there is no support for an obviousness rejection of the claimed subject matter as a whole because AAPA and Atkinson fail to disclose each element of the claims or to suggest the missing elements.

In the Final Office Action, the Examiner argues, in part, that

Applicant's arguments . . . have been fully considered but they are not persuasive. . . [The] applicant argues that not all limitations are disclosed in the AAPA and Atkinson combination because Atkinson does not disclose monitoring the output current of a battery. Examiner disagrees. **Atkinson is not relied upon to disclose monitoring output current of a battery. Atkinson is only relied upon to disclose monitoring current in real time by hardware components.** As described above, Atkinson discloses monitoring current in real time by hardware components in column 5, lines 1-15. Therefore, all limitations are disclosed by the AAPA and Atkinson combination regardless if Atkinson discloses monitoring output current of a battery. Emphasis added.

Thus, it is submitted that the Examiner is conceding that Atkinson is NOT being used to reject the element of "monitoring output current of a battery." In addition, the Office Action mailed 2/22/2007 states on page 3 that **"AAPA does not disclose continuously monitoring, in real time by hardware components, the output current of the power adapter or battery and instantaneously reducing the frequency at which the processor operates if the power output exceeds a threshold current level."** Emphasis added. Thus, the Examiner has also conceded that at least the AAPA **does not teach or suggest** continuously monitoring the *output current of the battery*. Examiner's Admitted Non-Disclosure (EAND hereinafter). Therefore, because the previous Office Action's EAND states in part that "AAPA does not disclose continuously monitoring, in real time by hardware components, the output current of the power adapter or battery," and the Examiner presently concedes that Atkinson is NOT being used to reject the element of "monitoring output current of a battery," all of the elements of the pending claims are not found in any combination in the references and it is therefore impossible to render the subject matter of claim 20 as a whole obvious based on any combination of the patents. As a result, the explicit terms of 35 U.S.C. §103(a) cannot be met and the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to claim 1, and a rejection under 35 U.S.C. §103(a) is defective and should be withdrawn.

Similarly, independent claims 8, 12, 13, 20 and 23 recite, among other things, elements of monitoring an output current of the battery. As explained above, neither AAPA nor Atkinson teach or suggest, monitoring an output current of the battery. Therefore, the rejections of these claims are also defective and should be withdrawn.

Dependent claims 2-7, 9-10, 14-16 and 21-22 depend from and further limit claims 1, 8, 13 or 20 and are also deemed to be in condition for allowance for at least that reason. See MPEP 2143.03.

Other reasons for the patentability of claims 1-23 have been previously presented and will be maintained should the filing of an appeal brief become necessary.

In conclusion, as discussed above, the EAND from the previous Office Action states that "AAPA does not disclose continuously monitoring, in real time by hardware components, the output current of the power adapter or battery" and the present rejection states that "Atkinson is not relied upon to disclose monitoring output current of a battery. Atkinson is only relied upon to disclose monitoring current in real time by hardware components." Therefore, it is submitted that because, as the Examiner has conceded, neither AAPA nor Atkinson teach or suggest all the elements recited in the pending claims, it is impossible to render the subject matter of claim

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1 as a whole obvious based on any combination of the references, and the explicit terms of the statute cannot be met. As a result, the examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to claim 1, and a rejection under 35 U.S.C. §103(a) is defective and should be withdrawn.

Respectfully submitted,


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on	<u>September 17, 2007</u>
	Date
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